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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/940,974
Filing Date: August 28, 2001
Appellant(s): DICKERSON, WAYNE LEWIS

Joseph J. Christian
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/21/07 appealing from the Office action mailed 8/20/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,877,034	MACHIN et al	4-2005
6,411,936	SANDERS	6-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23 and 26-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it is not clear how one would go about assessing the impact of each solution. The assembled solutions are hypothetical based on the industry. The number solutions for a given industry are endless. There is nothing in the specification that clearly sets forth steps one would take that would enable one to assess the impact of all possible solutions.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it is not clear what the conflict resolution rules are and it is not clear how they are implemented in such a way to determine a solution.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23 and 26-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. The claimed invention lacks concreteness since the claims are, in a sense, directed to brainstorming to come up with potential solutions to potential problems. There is no objective methodology explaining how to identify solutions to problems that don't necessarily exist. Additionally, the claimed conflict resolution rules are not repeatable since there are no guidelines or explicitly methodology set forth in the specification that would enable one of ordinary skill in the art to select a solution that has a positive impact on one metric but a negative impact on another solution.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23 and 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machin et al, US 6,877,034, in view of Sanders, US 6,411,936.

As per claim 23, Machin et al teaches identifying operational metrics for the industry, wherein the operational metrics includes a factor used to measure health or viability of a generic company in the specific industry (figs. 12 and 13 – a set of metrics are identified to evaluate a call center – these metrics inherently measure health or viability of the call center); assembling a set of solutions for application for a specific industry, wherein the set includes one of decision, an action, a product and a service (Since Machin et al is set up so that one can independently log in to the system and perform the gap analysis wherein the set of solutions is pulled from a database, it seems that these solutions associated with industry metrics are set forth prior to any gap analysis taking place. Based on the industry, in the example given it is a call center, a set of metrics is established. Once the gap analysis is performed on each of the metrics, a printout of a summary of potential solutions available on the market for narrowing or eliminating that gap is presented. These solutions must be previously set forth based on the metrics for the specific industry); comparing current operational performance of the company to an operational performance of another company within the industry to expose performance gaps (column 11, line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the performance gap between the requesting user and a peer group); and identifying a solution based upon the impacts to address the exposed performance gaps (column 12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap and ranks the solutions in descending order with the best solution at the top; see fig 14 also - for each performance gap, based on the metrics, an optimal decision index is calculated based on cost to implement, time to implement, risk to implement and return on investment to implement – that

with the lowest optimal decision index is the best proposed solution for that performance gap (column 13, lines 22-27)) and outputting the solution from the computer system (see fig 14), but does not explicitly teach assessing impacts of application of the solutions on operational metrics prior to any comparison between companies. However, Sanders teaches a continuous closed loop process wherein enterprise value enhancement solutions are updated based on feedback information. Sanders teaches a performance processor is used to compile a set of solutions that are mapped to causals and functions of the enterprise (column 14, lines 10-65). The globally networked total solution system of Sanders delivers value enhancement through solutions sets most appropriate for execution by specific functions for delivery of enhanced value (column 6, lines 57-60). Regression or other similar analysis is used to determine the highest confidence measure of success for particular solutions (column 14, lines 15-25). Therefore, it would have been obvious at the time of the invention to incorporate the established solutions of Sanders into Machin et al's gap analysis system to provide recommended solutions and best practices for industry metrics that can be easily accessed based on the gap analysis. The access of the established solutions would simplify and quicken the gap analysis procedure. The combination of Machin and Sanders teaches inventory turnover and number of customers (see fig. 9 – metric includes inbound calls per 8 hour shift, i.e., number of calling customers; fig 14. – call turnover is included) but does not teach the specific industry is the grocery store industry. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim

drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

As per claim 26, Machin et al teaches applying conflict resolution rule when a solution has a positive or negative impact on the metric (see fig 14. and column 12, lines 16-30 – the gap versus solution optimizer looks at each gap and each solution and estimates the impact of the solution on the performance gap) and determining which solution should be implemented (column 12, lines 16-30; column 13, lines 22-26 – determines which solution is optimal).

As per claim 27, Machin et al teaches benchmarking a company process or function on an articulated basis (column 13, lines 28-35), but does not explicitly teach repeating the steps automatically at a scheduled interval. Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to repeat the steps automatically at a scheduled interval as a way to monitor the company's performance. By automatically repeating at scheduled intervals, the benchmarking process of Machin et al, the company would be more aware of it's performance based on the benchmarking calculations leading to a more accurate view of the company's performance.

As per claim 28, Machin et al teaches the another company is a best in class company (column 3, lines 26-34 – benchmarking involves comparing the vital statistics of one enterprise against those of a peer group).

As per claim 29, Machin et al teaches identifying operational metrics for the industry, wherein the operational metrics includes a factor used to measure health or viability of a generic company in the specific industry (figs. 12 and 13 – a set of metrics are identified to evaluate a call center – these metrics inherently measure health or viability of the call center); assembling a set of solutions for application for a specific industry, wherein the set includes one of decision, an action, a product and a service (Since Machin et al is set up so that one can independently log in to the system and perform the gap analysis wherein the set of solutions is pulled from a database, it seems that these solutions associated with industry metrics are set forth prior to any gap analysis taking place. Based on the industry, in the example given it is a call center, a set of metrics is established. Once the gap analysis is performed on each of the metrics, a printout of a summary of potential solutions available on the market for narrowing or eliminating that gap is presented. These solutions must be previously set forth based on the metrics for the specific industry); comparing current operational performance of the company to an operational performance of another company within the industry to expose performance gaps (column 11, line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the performance gap between the requesting user and a peer group); generating a value proposition by identifying a solution based on the impacts to address the exposed performance gaps (column 12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap and ranks the solutions in descending order with the best solution at the top; see fig 14 also – for each performance gap, based on the metrics, an optimal decision index is calculated based on cost to implement, time to implement, risk to implement and return on investment to implement

– that with the lowest optimal decision index is the best proposed solution for that performance gap (column 13, lines 22-27)) and outputting the value proposition from the computer system (see fig 14), but does not explicitly teach assessing impacts of application of the solutions on operational metrics prior to any comparison between companies. However, Sanders teaches a continuous closed loop process wherein enterprise value enhancement solutions are updated based on feedback information. Sanders teaches a performance processor is used to compile a set of solutions that are mapped to causals and functions of the enterprise (column 14, lines 10-65). The globally networked total solution system of Sanders delivers value enhancement through solutions sets most appropriate for execution by specific functions for delivery of enhanced value (column 6, lines 57-60). Regression or other similar analysis is used to determine the highest confidence measure of success for particular solutions (column 14, lines 15-25). Therefore, it would have been obvious at the time of the invention to incorporate the established solutions of Sanders into Machin et al's gap analysis system to provide recommended solutions and best practices for industry metrics that can be easily accessed based on the gap analysis. The access of the established solutions would simplify and quicken the gap analysis procedure. The combination of Machin and Sanders teaches inventory turnover and number of customers (see fig. 9 – metric includes inbound calls per 8 hour shift, i.e., number of calling customers; fig 14. – call turnover is included) but does not teach the specific industry is the grocery store industry. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

As per claim 30, Machin et al teaches identifying operational metrics for the industry, wherein the operational metrics includes a factor used to measure health or viability of a generic company in the specific industry (figs. 12 and 13 – a set of metrics are identified to evaluate a call center – these metrics inherently measure health or viability of the call center); assembling a set of solutions for application for a specific industry, wherein the set includes one of decision, an action, a product and a service (Since Machin et al is set up so that one can independently log in to the system and perform the gap analysis wherein the set of solutions is pulled from a database, it seems that these solutions associated with industry metrics are set forth prior to any gap analysis taking place. Based on the industry, in the example given it is a call center, a set of metrics is established. Once the gap analysis is performed on each of the metrics, a printout of a summary of potential solutions available on the market for narrowing or eliminating that gap is presented. These solutions must be previously set forth based on the metrics for the specific industry); comparing current operational performance of the company to an operational performance of another company within the industry to expose performance gaps (column 11, line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the performance gap between the requesting user and a peer group); generating a value proposition

by identifying a solution based on the impacts to address the exposed performance gaps (column 12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap and ranks the solutions in descending order with the best solution at the top; see fig 14 also – for each performance gap, based on the metrics, an optimal decision index is calculated based on cost to implement, time to implement, risk to implement and return on investment to implement – that with the lowest optimal decision index is the best proposed solution for that performance gap (column 13, lines 22-27)) and outputting the value proposition from the computer system (see fig 14), but does not explicitly teach assessing impacts of application of the solutions on operational metrics prior to any comparison between companies. However, Sanders teaches a continuous closed loop process wherein enterprise value enhancement solutions are updated based on feedback information. Sanders teaches a performance processor is used to compile a set of solutions that are mapped to causals and functions of the enterprise (column 14, lines 10-65). The globally networked total solution system of Sanders delivers value enhancement through solutions sets most appropriate for execution by specific functions for delivery of enhanced value (column 6, lines 57-60). Regression or other similar analysis is used to determine the highest confidence measure of success for particular solutions (column 14, lines 15-25). Therefore, it would have been obvious at the time of the invention to incorporate the established solutions of Sanders into Machin et al's gap analysis system to provide recommended solutions and best practices for industry metrics that can be easily accessed based on the gap analysis. The access of the established solutions would simplify and quicken the gap analysis procedure. The combination of Machin and Sanders teaches inventory turnover and

number of customers (see fig. 9 – metric includes inbound calls per 8 hour shift, i.e., number of calling customers; fig 14. – call turnover is included) but does not teach the specific industry is the grocery store industry. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

As per claim 31, it is the system for performing the method of claim 29. Therefore, since Machin et al teaches a computer system, the same rejections as applied to claim 29 is applied to claim 31. Further, the combination of Machin and Sanders teaches inventory turnover and number of customers (see fig. 9 – metric includes inbound calls per 8 hour shift, i.e., number of calling customers; fig 14. – call turnover is included) but does not teach the specific industry is the grocery store industry. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use

must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

Claims 32 and 33 are directed to the program product stored on a recordable medium for performing the method of claims 29 and 30. Therefore, since Machin et al teaches a computer system, the same rejections as applied to claims 29 and 30 are applied to claims 32 and 33. Further, the combination of Machin and Sanders teaches inventory turnover and number of customers (see fig. 9 – metric includes inbound calls per 8 hour shift, i.e., number of calling customers; fig 14. – call turnover is included) but does not teach the specific industry is the grocery store industry. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed invention is not deemed to be patentably distinct over the prior art.

(10) Response to Argument

Appellant's arguments with respect to prior rejections of claims 23-33 under 35 USC 112, 1st paragraph, have been fully considered but they are not persuasive. The claims do not address the endless number of solutions that are assembled. Even though the metrics include at least one of a rate of inventory turnover and a number of customers per day, the assembled set of solutions is endless and there is no guarantee the solutions assembled with actually have any impact on the metrics in the assessment step. As claimed, when the solutions are assembled, the metrics are not considered. Only when the assessment takes place are the metrics considered in view of the solutions.

Appellant's arguments with respect to prior rejections of claim 26 under 35 USC 112, 1st paragraph, have been fully considered but they are not persuasive. In turning to the specification, it states the conflict resolutions rules dictate whether a solution should be identified for implementation. Once the solution is assessed and it is determined whether the solution has a negative or positive impact on a metric, it seems the conflict resolutions rules are applied in such a way to weigh one solution against another taking in to consideration the positive and negative impact of each solution. This, however, is not explained in such as a way to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Appellant argues the claims are statutory under 35 USC 101. Since there is no objective methodology explaining how to identify solutions to problems that don't necessarily exist, the claimed invention is not concrete. The assembly of solutions does not consider the metrics for the specific industry, therefore, during assessment of the impact of the solutions, there is no

guarantee the solutions assembled with actually have any impact on the metrics in the assessment step.

Appellant's arguments filed with respect to rejections under 35 USC 103(a) have been fully considered but they are not persuasive. Appellant argues there is no teaching or suggestion in either Machin or Sanders of a method that first identifies a plurality of operational metrics for the specific industry, wherein the specific industry is a grocery store industry, and wherein the operational metrics include at least one of a rate of inventory turnover and a number of customers a day. Examiner points out that Machin teaches metrics including inventory turnover and customers per day (see fig. 9 – metric includes inbound calls per 8 hour shift, i.e., number of calling customers; fig 14. – call turnover is included), but does not explicitly teach these metrics in the grocery industry. As claimed, however, these limitations merely recite various intended uses of the invention. In response to examiner's assertion that performing the claimed steps within a grocery store industry is mere intended use, Appellant asserts there are several structural differences between the claimed invention and that which is disclosed by Machin. Examiner respectfully disagrees. Any industry that considers inventory turnover and customers per day would be able to apply the claimed invention. There would be no structural difference and the claimed invention would perform the same calculations regardless if the data related to the grocery store industry.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Johnna R Loftis/

Examiner, Art Unit 3623

/Beth Van Doren/
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Conferees:

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